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10/617,585	07/11/2003	Donald Albert Paquet JR.	FA1048	3692

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/617,585
Filing Date: July 11, 2003
Appellant(s): PAQUET ET AL.

MAILED

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GROUP 1700

John H. Lamming
(Registration No. 34,857)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 17, 2006 appealing from the Office action mailed October 20, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6339126

Barkac et al.

1-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claim 5 (line 1), the recitation of "non-functional" is considered indefinite because the monomers cited within the Markush group contains species having various functional groups such as phenyl, fluoro, bicyclic, polycyclic, and aromatic with 2-3 rings functional groups.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16, 18-21 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Barkac et al. (US 6,339,126).

Art Unit: 1713

Barkae et al. (abstract; col. 1, line 25-50; col. 21, line 15 to col. 22, line 28) disclose a coatings composition and in example B, and Table 1, disclose a polycarboxylic acid functional polymer having Mw of 3550, and a MWD 1.25, and a crosslinking agent structure XII (col. 16, line 25-35) which comprises secondary amine structures (urethane). Barkae et al. (col. 16, line 5-35) clearly disclose that a polycarboxylic acid functional polyurethane may be used in the composition. Barkae et al. (col. 9, line 32-63) clearly shows a composition comprising both a functional acrylate monomers and functional methacrylate monomers. Barkae et al. (col. 10, line 26-45) disclose the composition can comprise hydroxyl groups containing monomers. Barkae et al. (col. 11, line 35 to col. 12, line 30) disclose the polycarboxylic acid functional polymer comprising glycidal (epoxy) functionalities (col. 12, line 25). Regarding the VOC limitation of claim 7, Barkae et al. (col. 1, line 50) indicate that the disclosed compositions have essentially zero VOC levels. Claims 1-16, 18-21, 26 are anticipated.

Regarding claims 9, 18, 21 which contains process related limitations, appellants must recognize that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

(10) Response to Argument

Appellants argue that “non-functional” is definite because it is defined in appellants’ specification. However, appellants fail to recognize that even the law allows appellants to be his own lexicographer in defining some specific terms that are not known in the art, appellants must recognize that the definitions provided by appellants must not violate the general teachings of the terminologies in the art.

Nevertheless, regarding appellants’ assertion that specification (page 7, lines 1-22) set forth the definition for the recited “non-functional” limitation to mean non-reactive and “functional” to mean reactive, the examiner can not find such definition anywhere in appellants’ specification. Appellants’ specification, particularly page 7, lines 1-22, merely disclose some examples of functional and non-functional monomers. However, such disclosure does not explicitly set forth the definition for “functional” or “non-functional”. In view of lack of definition provided for “non-functional”, the examiner has a reasonable basis to use the broadest interpretation of recited word “non-functional” commonly recognized by one of ordinary skill in the art of polymer chemistry.

Regarding claim 5, appellants are defining functional groups such as phenyl, fluoro, bicyclic, polycyclic, and aromatic with 2-3 rings functional groups as “non-functional” clearly violates the common terminology commonly recognized in the art of coating compositions. Therefore, the 102 rejection set forth is proper.

Art Unit: 1713


Regarding appellants' argument that the examiner has not objected to the appellants' definitions on grounds of lack of clarity, appellants must recognize that claim 5 which recited "non-functional" had been rejected under 112.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

 4/28/06
William K. Cheung, Ph. D. **WILLIAM K. CHEUNG**
PRIMARY EXAMINER

Conferees:

David Wu 
James Seidleck 